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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,570	05/03/2000	RUDOLF RITTER	268771	2038

909 7590 01/12/2005
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EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/530,570

Applicant(s)

RITTER, RUDOLF

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) 16-21 and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 16-21 and 22-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/20/2004.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is indefinite because it claims that the billed-for service (which in claim 1 is recited as a resource of the SIM card) is provided by an external service provider. It appears that the two claims are inconsistent since claim 1 is reciting that the resource is an internal resource and claim 6 is reciting that the resource is an external resource.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al (WO 97/40616) in view of Hayes et al (6,657,679).

Martineau shows incrementing at least one counter in a SIM card when at least one resource is used; determining an amount to be billed from the counter value wherein the amount to be billed corresponds to at least one of a service fee and a license fee; and billing the user comprising deleting a prepaid amount from an electronic wallet. Martineau does not show that the resources counted or billed are software or hardware resources of the SIM card. Hayes shows this element (e.g., providing additional capabilities via the card). It would have been obvious to one of ordinary skill in the art to modify the method of Martineau by providing for counting and billing of resources in the card as taught by Hayes in order to allow additional capabilities to be added to the system and billed for.

As to claim 2, Martineau in view of Hayes shows at least one billed for resource as a contactless interface.

As to claim 3, Martineau in view of Hayes shows that the billed for resource is based upon use of the card in an external system.

As to claim 4, Martineau in view of Hayes show independently billing for multiple resources independently (e.g., Hayes discusses individually charging for each additional capability added via the card).

As to claim 5, Martineau in view of Hayes shows incrementing the counter based on time of use.

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As to claim 7, Martineau in view of Hayes shows offering an external service and billing an amount corresponding to a service fee for its use.

As to claim 8, Martineau in view of Hayes show all elements of the claim except incrementing more than one counter for a single service to determining different fees. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Martineau by advancing a plurality of counters

As to claim 9, Martineau in view of Hayes show all elements except displaying the amount to be billed. It is notoriously old and well known in the art to show an amount to be billed on the mobile device in which the SIM is inserted. It would have been obvious to one of ordinary skill in the art to further modify the method of Martineau by displaying this information in order to allow the user to gauge how much money is being used.

As to claim 11, Martineau in view of Hayes show preparing a billing record and transmitting the billing record to a billing center via the telecommunications service. The combination inherently shows this since the charges are calculated by the SIM and when the system is functioning as a normal subscriber system (as opposed to strictly prepaid), the information must be passed to the telecommunications system in order for the charges be reflected in the user's account.

As to claim 12, Martineau in view of Hayes show all elements except preparing a billing record only when the amount counted by the counter exceeds a pre-defined amount. It is notoriously old and well known in the art to do so. It would have been

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obvious to one of ordinary skill in the art to further modify the method of Martineau by preparing a billing statement only when a counter exceeds a pre-defined amount in order to provide for a certain number of free or prepaid uses within a time period.

As to claim 13, Martineau in view of Hayes show all elements except sending the amount to be billed via SMS messages. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Martineau by sending the information via SMS messages in order to take advantage of pre-existing and standardized infrastructure.

As to claim 15, Martineau in view of Hayes shows all elements.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER